

EXPEDITED PROCEDURE

GROUP ART UNIT 2617

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PATENT

Our Case No. 9683/188

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)
	) Group Art Unit 2617
Hiroshi Kanto et al.	)
	) Examiner: Bryan J. Fox
Serial No.: 10/828,977	)
	) Conf. No. 5406
Filed: April 21, 2004	)
	)
For: MOBILE TERMINAL, COMMUNICATION	)
SYSTEM, AND METHOD FOR CHANGING	)
LOCATION REGISTRATION	)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests review of the final rejection mailed June 1, 2006 in the above-identified application. A notice of appeal is being filed concurrently, and is included herewith. This request is being timely filed with a one (1) month extension of time, which is enclosed herewith. Review is requested for the reasons indicated in the Remarks that begin on page 2 of this paper.

## REMARKS

Claims 5-27 are currently pending in this Application. For purposes of brevity, Applicant will only briefly discuss the factual and legal deficiencies in the 35 U.S.C. § 112 first paragraph and 35 U.S.C. § 103(a) rejections of Claims 5-27.

### 35 U.S.C. §112 first paragraph rejections factual and legal deficiencies

"To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention." see MPEP 2163(I) In the present application, the limitations in Claim 5 that are at issue are: "wherein said control unit further operable to attempt to register to said first mobile communication network only when said voice communication is not presently in progress." These limitations were newly added with the claim amendments filed on March 17, 2006. "While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure." see MPEP 2163(I)

On page 2 of the office action response filed July 19, 2006, Applicant indicated that paragraph 48 and Figure 8 of the specification implicitly describe the claimed limitations. Paragraph 48 describes a series of steps that include determining whether a mobile terminal user is calling through a second communication network, and repeating that process as long as the user is calling so that the call will not be disconnected when the mobile terminal is changed from the second communication network to a first communication network. In addition, Applicant's specification describes examples of voice communication and voice communication services with a mobile terminal in at least paragraph 26 of the specification. Further, a discussion of why voice communication cannot be changed from one communication network to another, but packet communication can be changed is discussed in at least paragraph 61 of Applicant's specification.

It is well known to one skilled in the art that calling on a mobile terminal can include voice communication. In addition, it is well known to one skilled in the art that while voice communication is in progress, the mobile terminal user is calling through a communication network. "The Examiner has the initial burden of presenting by a preponderance of the evidence why a person of skill in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims." see MPEP 2163.04 Applicant

respectfully asserts that this initial burden has not been met due to the factual errors in the rejections.

In the advisory action mailed August 14, 2006, it was indicated that voice communication is not mentioned in paragraph 48 or Figure 8 of Applicants specification. Applicant respectfully points out that such communication is implicitly disclosed and is well supported by the specification, as previously discussed. Applicant further points out that there is a strong presumption that an adequate written description of the claimed invention is present in the as-filed specification, and that a thorough reading and evaluation of the entire application followed by presentation of evidence or reasons why a person of ordinary skill in the art would be unable to recognize support for the claims is required to assert lack of support in the written description. see MPEP 2163(II)(A)

Applicant respectfully asserts that the subject matter of a claim does not need to be described literally in the specification using the same terms (see MPEP 2163.020), and neither the office action mailed June 1, 2006, nor the advisory action mailed August 14, 2006 provide adequate evidence or reasons why a person of ordinary skill in the art would be unable to recognize support for the claims in the specification. Accordingly, for at least the foregoing reasons, Applicant respectfully submits that it is clear factual and legal error to maintain the assertion that the specification does not support the described limitations.

With regard to Claims 19-27, the method of Claim 19 describes the step of transmitting from said mobile terminal to said first mobile communication network, a notification including an identifier only when voice communication is determined to not presently be in progress, and when it is determined that it is possible to register to said first mobile communication network. Support in the specification for the limitations "only when voice communication is determined to not presently be in progress" are at issue. Applicant respectfully asserts that such limitations are supported by the specification, for the previously discussed reasons, and that clear factual and legal error is present since inadequate evidence or support were provided as a basis for the 35 U.S.C. §112 first paragraph rejections.

On another note, MPEP 2162(III) requires that, following determination of the written description requirement, office personnel must complete a patentability determination under all the relevant statutory provisions of title 35 of the U.S. Code. In the present application, examination is incomplete since no such patentability determination of claims 5-13 and 19-27 has been performed or described, which is yet another legal deficiency of the rejections.

35 U.S.C. §103(a) factual and legal deficiencies

Claim 14 describes a management device operable to selectively update location registration data in response to receipt from each of said mobile terminals of a notification of a current registration of a respective mobile terminal to at least one of a first mobile communication network or a second mobile communication network. U.S. Patent No. 6,697,620 to Lamb et al. (hereinafter referred to as Lamb), on the other hand, clearly describes a mobile switching center (MSC) that receives a request for registration from a roaming mobile phone. (Col. 4 lines 56-61) The MSC notifies a universal location service register (ULSR) that registration has been requested. (Col. 4 lines 61-64) The ULSR then confirms the mobile phone can be registered, and sends a message to the MSC authorizing registration, or indicating that registration is not authorized. (Col. 5 lines 1-12) If registration is authorized, the ULSR updates a database to reflect that the mobile phone is currently registered at the MSC. (Col. 5 lines 2-6)

Applicant respectfully asserts that a request for registration from a mobile phone, and notification of a current registration describe two entirely different things. Clearly, Lamb describes a "request for registration" that occurs prior to the actual registration occurring, whereas Claim 14 describes receipt of notification from a mobile terminal of a "current registration." On page 4 of Applicant's response filed July 19, 2006 it is explained how receipt of a notification of a current registration from a mobile terminal, instead of a request for registration as described by Lamb is provided.

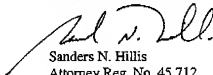
In addition, although Lamb uses the language "currently registered," clearly, a mobile phone is not "currently registered" in the Lamb system until the MSC receives authorization and completes the registration. Thus, Lamb teaches away from receipt from each of said mobile terminals of a notification of a current registration as described in Claim 14. Even if one was to construe the message of authorization transmitted by the ULSR of Lamb as a notification of current registration, Lamb's message is clearly received by the MSC from the ULSR, not from each of said mobile terminals as described in Claim 14.

To establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art see MPEP §2143.03. Clearly, the above-described limitations are not taught or suggested by the cited references and it is clear factual and legal error to maintain the present rejections of the Claims.

Claim 18 describes that an interval of time between transmission of said registration possibility information by said base station is adjustable in accordance with a distance of said base station from a center of said first mobile communication network. U.S. Patent Application Publication No. US 2001/0012776 A1 to Chandler et al. (hereinafter referred to as Chandler) describes delay calculated on the basis of the distance between stations for a shortest route determination. (Paragraph 17 and 18) In sharp contrast, Claim 18 describes an interval of time between transmission of registration possibility information that is adjustable in accordance with a distance of a base station from a center of a mobile communication network. Clearly, a distance between base stations to determine shortest routes, and a distance from a base station to the center of a communication network for an adjustable interval of time between transmission are describing two different measurements. Accordingly, Chandler teaches away and/or is silent with regard to the limitations described in Claim 18.

Each and every limitation of the present pending claims of this application are not taught, suggested, or disclosed by the cited references. Accordingly, Applicant respectfully asserts that a number of legal and factual deficiencies constituting errors are clearly present in the support of the 35 U.S.C. § 112 first paragraph, and the 35 U.S.C. § 103(a) rejections of the pending claims. Thus, Applicant respectfully requests that the panel issue a decision so indicating.

Respectfully submitted,



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